

Appl. No. : 09/144,897
Filed : September 1, 1998

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Mohamed K. Diab et al.
Appl. No. : 09/144,897
Filed : September 1, 1998
For : SIGNAL PROCESSING
APPARATUS
Examiner : Eric F. Winakur
Group Art Unit : 3768

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John M. Grover, Reg. No. 42,610

REQUEST FOR RECONSIDERATION FOR DECISION ON PETITION FOR PATENT

TERM EXTENSION – TERMINATION DELAY

Mail Stop PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request reconsideration of their Petition for Patent Term Extension according to the following comments.

Status

On June 30, 2008, Applicants filed a petition under 37 CFR § 1.181 for correction of patent term ("the Petition") in the above-identified application ("the Application"). The Petition included a request for patent term extension under 35 U.S.C. § 154(b)(1) for delays due to interference proceedings. The arguments and responses presented in this Response supplement those presented in the Petition.

On June 18, 2009, the Office of Patent Legal Administration ("the Office") mailed a decision on the Petition ("the Decision"). The Office granted the Petition in part, granting an additional 61 days of patent term for the period from favorable judgment in interference proceedings involving the Application to the last day on which an appeal to the interference decision could be filed.

The Office dismissed Applicants' request for:

(1) Termination Delay, which included an additional 332 days¹ of patent term extension for the time it took the Board of Patent Appeals and Interferences ("BPAI") to forward the application back to the Examiner for review; and

(2) Suspension Delay, which included an additional 247 days of patent term extension for delay caused by two Examiner initiated suspensions due to interference proceedings.

Remarks

Applicants respectfully disagree with the Office's dismissal of these requests and requests reconsideration of the Termination Delay.

In the Petition, Applicants submitted that the patent term extension should be adjusted by at least an additional **332 days** for the time it took the BPAI to forward the case to the Examiner following the interference.

In response, the Office cites to 37 C.F.R. § 41.205(a) in support of the arguments made by the Petitions Examiner in the present case. 37 C.F.R. § 41.205(a) is a narrowly applicable subsection entitled "Constructive notice; time for filing," and is contained in § 41.205 of the C.F.R. entitled "Settlement Agreements." The definition of the term "termination" provided in such a narrowly applicable context should not be read to apply more broadly to the patent term extension context. Moreover, as noted in the Applicants' Petitions, the plain language of the applicable statute, former 35 U.S.C. § 154(b), and the applicable regulation, 37 C.F.R. § 1.701, indicate that patent term extension should be allowed for extension of patent term if the issuance of a patent is "delayed *due to*" interference proceedings. These portions of the applicable statute and regulation should be granted greater interpretational weight than § 41.205. Clearly the delay at issue here was *due to* interference proceedings as it would not have occurred absent the interference.

Moreover, the length or duration of any delay due to the failure to promptly forward the application to the Examiner for review is entirely within the control of the Office, as opposed to delay caused by or even governed by actions of the Applicants.

¹ The original request was for 393 days of delay from judgment in the interference proceedings to the date on which the case was sent back to the Examiner for review. However, because the Office granted the 61 days from judgment to the last day on which an appeal could be filed, the number has been adjusted to 332 days.

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As such, fairness dictates that such unilateral Office imposed delay result in additional term extension under the present Applicants' petitions.

Based on at least the foregoing, "Termination" as used in 37 C.F.R. § 1.701 should therefore be read to include such delay caused by the USPTO and directly related to the interference process. Accordingly, Applicants respectfully request reconsideration on this issue and submit that the patent term extension should be adjusted according to 37 C.F.R. § 1.701(i) by at least an additional 332 days.

Summary

Applicants submit that the present application was delayed by at least 332 days in addition to the 191 days already granted by the Office. As such, Applicants submit that the patent term extension should reflect the cumulative total of at least **523 days** pursuant to 37 C.F.R. § 1.701 and request that the patent term extension be corrected to reflect at least this 523 day amount.

No fee is deemed due as none of 37 C.F.R. §§ 1.181, 1.182, or 1.701 indicate that a fee is due in conjunction with a request for reconsideration of a petition under 37 C.F.R. § 1.181 or § 1.182. However, in the event that a fee is due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 13, 2009

By: 

John M. Grover
Registration No. 42,610
Attorney of Record
Customer No. 20,995
(949) 760-0404